Mailed: September 7, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Safeco Financial Institutions Solutions, Inc.,
assignee of INA Corporation[1]

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Serial No. 76091230

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Faye L. Tomlinson of Christensen O'Connor Johnson Kindness PLLC for applicant.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Simms, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant filed on July 18, 2000, an application to register on the Principal Register the mark shown below

iORION

for services amended to read "policy management system

[1] The records of the Assignment Branch of the USPTO indicate that the involved intent-to-use based application has been assigned to Safeco Financial Institutions Solutions, Inc. See Reel 2526, Frame 0713.

accessible over the Internet for on-line computerized tracking of insurance coverages" in International Class 36. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the five previously registered marks listed below, all issued to Orion Capital Corporation:[2]

(1) Registration No. 2,338,603, issued April 4, 2000, for the mark ORION for the following services:

> "management of independent insurance agency representatives" in International Class 35, and
>
> "administration of auto, property, casualty, marine, professional liability and workers compensation insurance underwriting services; insurance claims administration, management and adjusting services; reinsurance services, namely sharing insurance risks, either by accepting such risks or placing them with other insurers; loss adjustment and prevention services; auto, property, casualty, marine, professional liability and workers compensation insurance administration, management and consulting services; evaluation of insurance programs of others in order

[2] The Board notes that Registration Nos. 2,316,389 (ORIONAUTO) and 2,601,643 (ORION AUTOLINK) have been assigned to Orionauto, Inc. See Reel 2530, Frame 0007. Even though the records of the USPTO now indicate that the five cited registrations are owned by two entities, the Board does not know if the original registrant, Orion Capital Corporation, and the assignee, Orionauto, Inc., are related companies.

> to analyze current or potential risks, to recommend corrective actions, to conduct follow-up assessments for containing risks, and to conduct insurance-related programs; underwriting extended warranty contracts in the field of personal automobile insurance; and insurance brokerage" in International Class 36;

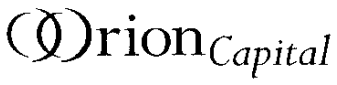
(2) Registration No. 2,316,389, issued February 8, 2000, for the mark ORIONAUTO for "insurance services, namely, underwriting property and casualty risk, insurance brokerage, insurance claims administration" in International Class 36;

(3) Registration No. 2,601,643, issued July 30, 2002, for the mark ORION AUTOLINK for the following goods and services:

> "computer programs and software that may be downloaded from, or accessed on a global or other computer network for use in insurance administration, claims adjustment, underwriting, and transacting business with insurance agents, transmitting applications for insurance, price quotes, endorsement forms for policy changes, customer policy information, customer claim information, insurance policy-related data, and customer-related data, processing premiums and other customer payments, and receiving customer information requests and referring them to networked agents, and instruction and user manuals therefor" in International Class 9; and

> "insurance services, namely, insurance claims adjustment, insurance administration, issuing policies and administering claims and premium payments, insurance brokerage, processing of insurance claims and payment data, insurance consultation and insurance underwriting in the field of non-standard automobile insurance" in International Class 36;

(4) Registration No. 2,197,538, issued October 20, 1998, for the mark shown below



for the following services:

> "administration of property, casualty, marine, professional liability and workers compensation insurance underwriting services; insurance claims administration and adjusting services; reinsurance services, namely, sharing insurance risks, either by accepting such risks or placing them with other insurers; loss adjustment and prevention services; insurance consulting services, namely, evaluation of insurance programs of others to analyze current or potential risks, to recommend corrective actions and to conduct follow-up assessments for containing risks and to conduct insurance-related programs; property, casualty, marine, professional liability and worker's compensation insurance consulting services, namely, evaluation of insurance programs of others in order to analyze current or potential risks, to recommend corrective actions and

to conduct follow-up assessments for containing risks and to conduct insurance-related programs" in International Class 36; and

(5) Registration No. 2,445,436, issued April 24, 2001,

for the mark shown below

(the word "specialty" is disclaimed) for the following services:

"management of independent insurance agency representatives" in International Class 35; and

"administration of property, casualty, marine, professional liability and workers compensation insurance underwriting services; insurance claims administration and adjusting services; reinsurance services, namely sharing insurance risks, either by accepting such risks or placing them with other insurers; loss adjustment and prevention services; insurance consulting services, namely, evaluation of insurance programs of others in order to analyze current or potential risks, to recommend corrective actions and to conduct follow-up assessments for containing risks and to conduct insurance-related programs; property, casualty, marine, professional liability and workers compensation insurance consulting services, namely evaluation of insurance programs of others in order to analyze current or potential risks, to recommend corrective actions and to conduct follow-up

> assessments for containing risks and to conduct insurance-related programs" in International Class 36.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of applicant's services and the cited registrant's goods and services. It is well settled that goods and/or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner or

that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods and/or services. See In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); and In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Of course, it has been repeatedly held that in determining the registrabiliy of a mark, this Board is constrained to compare the goods and/or services as identified in the application with the goods and/or services as identified in the registration(s). See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, applicant identified its services as a "policy management system accessible over the Internet for on-line computerized tracking of insurance coverages." The cited registrant's goods in Registration No. 2,601,643 for ORION AUTOLINK are identified as "computer programs and software that may be downloaded from, or accessed on a

global or other computer network for use in insurance administration, claims adjustment, underwriting, and transacting business with insurance agents, transmitting applications for insurance, price quotes, endorsement forms for policy changes, customer policy information, customer claim information, insurance policy-related data, and customer-related data, processing premiums and other customer payments, and receiving customer information requests and referring them to networked agents, and instruction and user manuals therefor."

Also, the most relevant of registrant's identified services include "insurance consulting services, namely, evaluation of insurance programs of others in order to analyze current or potential risks, to recommend corrective actions and to conduct follow-up assessments for containing risks and to conduct insurance-related programs" (Registration No. 2,338,603 for ORION, Registration No. 2,197,538 for ORION CAPITAL and design, and Registration No. 2,445,436 for ORION SPECIALTY and design); "property, casualty, marine, professional liability and workers compensation insurance consulting services, namely evaluation of insurance programs of others in order to analyze current or potential risks, to recommend corrective actions and to conduct follow-up assessments for containing

risks and to conduct insurance-related programs" (Registration No. 2,197,538 for ORION CAPITAL and design, and Registration No. 2,445,436 for ORION SPECIALTY and design); "administration of property, casualty, marine, professional liability and workers compensation insurance underwriting services" (Registration No. 2,338,603 for ORION, Registration No. 2,197,538 for ORION CAPITAL and design, and Registration No. 2,445,436 for ORION SPECIALTY and design); "insurance claims administration" (Registration No. 2,316,389 for ORIONAUTO); "insurance claims administration and adjusting services" (Registration No. 2,197,538 for ORION CAPITAL and design, and Registration No. 2,445,436 for ORION SPECIALTY and design); and "insurance claims adjustment, insurance administration" (Registration No. 2,601,643 for ORION AUTOLINK).

It is clear that, as identified, applicant's services and the goods and highlighted services of registrant are or can be used for the same or closely related purposes. Specifically, applicant's policy management system of on-line tracking of insurance coverages is broad enough to encompass a system of management for the above-specified insurance services offered by registrant (e.g., evaluation of insurance programs of others; insurance administration; insurance claims administration). Also, the purpose of

registrant's services is nearly identical to the purpose of its computer programs and software that may be accessed through the Internet for use in insurance administration. Thus, applicant's broadly worded identification of services relating to on-line tracking of insurance coverages is also related to registrant's goods.

Applicant acknowledges that the "[services] might travel through the same channels of trade," but argues that the "purchasers and users of registrant's and Appellant's services are professionals in the insurance industry" (brief, p. 6). The Examining Attorney does not contradict this assertion, and the involved identifications of services (particularly those set forth earlier herein as the most relevant) in fact indicate that these services are purchased by professionals in the insurance industry. We agree that purchasers, either institutional or individual, of insurance services would make such purchasing decisions with at least some degree of care. However, even sophisticated purchasers are not immune from confusion as to the source of the goods and services, particularly when they are sold under similar marks. See Wincharger Corporation v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289 (CCPA 1962); and In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

Here we find that the involved goods and services are closely related, would be sold through the same or overlapping channels of trade, and could be sold to similar classes of purchasers, so that if sold or marketed under similar marks, confusion as to source by consumers would be likely.

Turning now to the marks, when analyzing applicant's mark and each of the registered marks, it is not improper to give more weight to a dominant feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. See In re Dixie Restaurants Inc., supra; In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987).

Applicant's mark is iORION (as shown above). The Examining Attorney submitted the Acronym Finder definition of "i" as meaning, inter alia, "Internet." The purchasing public will likely understand the "i" to refer to "Internet," particularly in the context of applicant's identified services. See In re Zanova, Inc., 59 USPQ2d 1300 (TTAB 2001). This letter has an obvious descriptive significance for applicant's services. As for the cited marks, the secondary terms "specialty," "capital," "auto" and "autolink" do not serve to distinguish the marks in any

meaningful way. Thus, we find that the dominant portion of applicant's mark and registrant's multiple-word and composite marks is the arbitrary word "ORION." That is, purchasers are unlikely to distinguish the marks based on the highly suggestive or descriptive additional wording, when the arbitrary word ORION is identical in all of the marks.

The marks (applicant's and each of registrant's) are similar in sound and appearance. Obviously, the connotation of the term ORION is the same for both applicant's and registrant's marks. We disagree with applicant's argument that its mark creates a unique impression different from that of registrant's marks. Even if purchasers do specifically remember the differences in the involved marks, they may believe that applicant's mark is simply a new version of registrant's ORION marks for a new product or service offered by registrant. See In re Dixie Restaurants, supra.

We find that, when considered in their entireties, each of the marks ORION, ORIONAUTO, ORION AUTOLINK, ORION CAPITAL and design, and ORION SPECIALTY and design, on the one hand, and iORION on the other, are similar in sound, appearance, connotation and commercial impression. See

Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Applicant argues that it has identified "at least six active records for marks in International Class 36 for financial services that incorporate the word 'orion'"; and that therefore the cited marks should be accorded only a narrow scope of protection. This argument is not supported by the record. In fact, despite having been advised by the Examining Attorney (Final Office action, unnumbered page 2) that applicant's mere typed list was not sufficient to make the application/registrations of record, applicant did not later submit photocopies or any other evidence supporting this argument. In any event, we note that applicant's typed list includes an application (which is evidence of nothing except that it was filed); a few third-party registrations for non-insurance services such as financial information provided by satellite and electronic means, real estate brokerage services and prepaid telephone credit card services; and a reference to applicant's registration (No. 1,749,001, which was assigned to INA Corporation in 1999, and which expired in 2003 for failure to renew).

Applicant strongly contends that there have been no instances of actual confusion "even though the marks have co-existed in one form or another for almost fifteen

years." (Brief, p. 7.)[3] We presume that applicant is referring to no known instances of actual confusion involving the cited marks and the mark originally owned by applicant's predecessor-in-interest, ORION-ON-LINE REMOTE INSURANCE ORDER NETWORK (see Registration No. 1,749,001). The problems with this argument are myriad -- applicant has applied for the mark iORION not ORION-ON-LINE REMOTE INSURANCE ORDER NETWORK; applicant's application is based on a claimed intention to use the mark in commerce; there is no information of record regarding if or when applicant commenced use of its mark or as to the nature and extent of registrant's use of its marks; and there is no input from the registrant. In any event, the test is likelihood of confusion, not actual confusion. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against applicant as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d

[3] Applicant also stated in its brief (p. 7) that "the marks have co-existed for over ten years without any known incidents of actual confusion."

1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.